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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/669,298 09/25/00 AHMAD

S HA0744 NP

EXAMINER

023914 HM12/0723

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ART UNIT

PAPER NUMBER

1624

DATE MAILED:

07/23/01

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/669,298

Applicant(s)
Ahmad et al.

Examiner
Hong Liu

Art Unit
1624



-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-62 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-62 are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-31, drawn to the compounds and compositions of the formula depicted in claim 1 wherein X is N, n=1, classified in class 548, subclass 954.
 - II. Claims 1-31, drawn to the compounds and compositions of the formula depicted in claim 1 wherein X is N, n=2, classified in class 548, subclass 950.
 - III. Claims 1-31, drawn to the compounds and compositions of the formula depicted in claim 1 wherein X is N, n=3, classified in class 548, subclass 517.
 - IV. Claims 1-31, drawn to the compounds and compositions of the formula depicted in claim 1 wherein X is N, n=4, classified in class 546, subclass 184.
 - V. Claims 1-31, drawn to the compounds and compositions of the formula depicted in claim 1 wherein X is N, n=5, classified in class 540, subclass 596.
 - VI. Claims 1-31, drawn to the compounds of the formula depicted in claim 1 wherein X is CR5, n=1, classified in class 544, subclass 242.
 - VII. Claims 1-31, drawn to the compounds and composition not included in Groups I-VI, classified in classes and subclasses depending on the nature of the substituents.
 - VIII-XV. Claims, 32-43, drawn to one of the methods for treatment of seven disorders, classified in class 514 and various subclasses.

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XVI. Claims 44-62, drawn to a combination of a compound as defined in 1 and another pharmaceutical agent, classified in classes and subclasses depending on the nature of the other pharmaceutical agent.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-VII are directed to structurally dissimilar compounds such that the variable core created by varying the definitions of the formula do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention would not render obvious the others, for example, piperidine is different from pyrrolidine. Thus, separate searches in the literature as well as in the U.S. Patent Clarification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

3. Inventions I-VII and VIII-XVI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case more than one use exists for compounds of Group I as evidenced by claims 32-43, drawn to a variety of diverse uses. Additionally, the various uses would raise issues of enablement separate from that of the compound claims and would require

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art-recognized evidence that activity relied on its reasonably correlated to in vivo efficacy for the uses claimed. A telephone call was made to Mr. Burton Rodney on 07/17/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
July 19, 2001


Mukund Shah
Supervisory Patent Examiner
Art Unit 1624